

REMARKS

Claims 1-21 remain pending in this application. In the Office Action of January 12, 2005, all claims were rejected. Applicants hereby respond and traverse the rejections as follows.

Objection to Drawings

The Draftsperson has objected to the drawings as set forth in the Notice of Draftsperson's Patent Drawing Review, dated March 5, 2004, and the Examiner has requested that Applicants correct the drawings. With this Response, Applicants have filed a Submission of Corrected Formal Drawings.

Specification

The Examiner has objected to the Specification because the Abstract exceeds 150 words. With this Response, Applicants have amended to Specification by providing a replacement Abstract that does not exceed 150 words.

Response to Claim Rejections Under 35 U.S.C. § 102(b)

Claims 1-5, 10 and 18-19 stand rejected under 35 U.S.C. § 102(b) as being anticipated by items U and V cited in Paper #8, PTO-892, which the Examiner refers to as "Homestore.com." Applicants respectfully request reconsideration and withdrawal of this rejection.

Applicants submit that the rejection under 35 U.S.C. § 102(b) is improper because the cited references are multiple references rather than a single reference. Item U appears to be copies of archived pages from the Homestore.com website. Item V, however, is not information from that website, but is instead an online Wall Street Journal article stating that iMove.com "hopes to automate the moving process." This article was printed from a website that is not the Homestore.com website. Applicants submit, therefore, that The Wall Street Journal article (item V) is a separate reference. As set forth in the Manual of Examining Procedure, generally only one reference should be used in making a rejection under section 102. MPEP § 2131.01. Thus, Applicants respectfully submit that the rejection of claims 1-5, 10 and 18-19 under 35 U.S.C. § 102(b) based on items U and V is improper.

Even if items U and V were a single reference, Applicants respectfully submit that the items U and V do not disclose all of the features of claim 1. At the very least, items U and V,

even taken together, do not disclose “processing an original transaction by accepting customer input requested by a host; . . . and processing a secondary transaction for the auxiliary service between the customer and a service provider . . . and wherein the customer input for the originating transaction is used by the host to expedite the processing of the secondary transaction,” as recited in claim 1.

In the pending Office Action, the Examiner asserts that the Homestore.com website (item U) and the Wall Street Journal article (item V) collectively disclose such a secondary transaction. The Examiner argues that items U and V disclose automating the moving process online, and suggests that they disclose more than a pass through portal because “all moving companies operate under a common set of policies and procedures.” The Examiner further argues that items U and V disclose processing bids for moving services (which the Examiner reads as the “originating transaction”) and purchasing those moving services (which the Examiner reads as the “secondary transaction”).

Applicants respectfully submit, however, that items U and V do not teach a host’s use of an originating transaction to expedite a secondary transaction, as recited in Applicants’ claims. At the very most, items U and V only suggest the use of customer input for a single transaction between the customer and a service provider. That transaction is the purchase of a moving service from a single mover. Although the Wall Street Journal article (item V) states that iMove.com “hopes to automate the moving process,” that hoped-for automation appears only to potentially provide customer information to automate the bidding process by which the customer selects a single vendor for a single transaction. Nothing in items U and V teaches or suggests that any information provided by the customer is used by the host to expedite a secondary transaction between the customer and another separate provider of an auxiliary service. For example, the credit card information that may be used in purchasing of moving services from Homestore.com (item V) does not come from the information provided based on questions related to renting a truck (item U). The two transactions, i.e. purchasing moving services as well as renting a truck, are two separate transactions and are not facilitated by Homestore.com, other than the site acting as a portal for the Ryder truck rental service. As another example, there is no disclosure or suggestion that information that the customer provides for a purchase of services

Response to Office Action  
US Patent Application No. 10/083,726

from the mover (i.e., the originating transaction) is used to expedite any other transaction with another service provider of auxiliary services. Applicants respectfully submit, therefore, that items U and V do not anticipate claim 1.

Claims 2-4, 18, and 19 also include the above described feature of “processing an original transaction by accepting customer input requested by a host; . . . and processing a secondary transaction for the auxiliary service between the customer and a service provider . . . wherein the customer input for the originating transaction is used by the host to expedite the processing of the secondary transaction.” In addition, each of claims 5 and 10 depend from and include all of the features of claim 4. Applicants respectfully submit, therefore, that at least for the reasons discussed above, items U and V do not anticipate claims 2-5, 10 and 18-19, even if items U and V were properly combined as a single reference.

Response to Claim Rejections Under 35 U.S.C. § 103(a)

*Claims 6-9*

Claims 6-9 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over item U (Homestore.com) and item V (The Wall Street Journal article) in view of the Official Notice taken by the Examiner in Paper #8 regarding moving services. Applicants respectfully request reconsideration and withdrawal of this rejection.

Each of claims 6-9 depends from and includes all of the limitations of claim 4. Claim 4 is directed to a method of providing auxiliary services relating to moving and relocating in a computer network marketplace upon completion of an originating transaction relating to the rental of moving equipment between a customer and a host. The method includes processing an originating transaction by accepting customer input requested by a host wherein the host operates the marketplace; enabling a customer in the computer network marketplace to access content describing an auxiliary service relating to the originating transaction, wherein the auxiliary service relates to moving and relocating and the originating transaction relates to the renting of moving equipment; and processing a secondary transaction for the auxiliary service between the customer and a service provider and accepting a payment from the customer for the service wherein the service provider is listed in the marketplace at the discretion of the host and wherein the customer input for the originating transaction is used by the host to expedite processing of the

Response to Office Action  
US Patent Application No. 10/083,726

secondary transaction and wherein the customer controls the secondary transaction more than the service provider. Claim 6 includes all of the features of claim 4 and further recites that the content describing an auxiliary service includes loading/unloading service information. Claim 7 includes all of the features of claim 6 and further recites that the content describing an auxiliary service further includes packing/unpacking service information and house cleaning service information. Claim 8 includes all of the features of claim 7 and further recites that the content describing an auxiliary service further includes landscaping service information, carpet cleaning service information, painting service information, and garbage removal service information. Claim 9 includes all of the features of claim 4 and further recites that the content describing an auxiliary service includes hotel reservation information.

The Examiner has taken Official Notice that it is old and well-known to those of ordinary skill in the art to ascertain the need for the services recited in claims 6-9 in connection with a move. Applicants respectfully submit, however, that even if the need for such services were apparent, claims 6-9 are patentable over the cited art for at least the following reasons.

First, to establish a *prima facie* case of obviousness under 35 U.S.C. § 103(a), there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. MPEP § 2142. The teaching or suggestion to make the claimed combination must be found in the prior art, and not based on Applicant's disclosure. *Id.* As discussed below, Applicants respectfully submit that the record does not provide sufficient support to establish this requirement.

The Examiner appears to conclude that recognition of the need for the recited moving services is sufficient motivation to combine the cited references. Items U and V, however, do not suggest such a motivation. Item U does not suggest automation of the process of purchasing moving services from multiple vendors. Item V is directed to a very different problem than Applicants' invention, i.e. item V is directed to automating a bidding process, whereas Applicants' invention is directed to using an originating transaction to facilitate a second transaction with a separate auxiliary service provider. Thus, the Examiner appears to rely solely on the knowledge in the art of the need for moving services in combining the cited references

Response to Office Action  
US Patent Application No. 10/083,726

and/or on Applicants' disclosure. The level of skill in the art, however, cannot be relied upon alone to provide the suggestion to combine references. MPEP § 2142. Moreover, it is impermissible to resort to hindsight based on the Applicants' disclosure to reach a conclusion that such a suggestion or motivation exists. See MPEP § 2142.

In addition, a finding of obviousness requires that all claim limitations of the Applicant's invention must be taught or suggested by the prior art. MPEP § 2143.03. Even if it were proper to combine items U and V and the Official Notice, Applicants respectfully submit that that combination does not teach or suggest all of the elements of Applicants' claims 6-9. Each of claims 6-9 depends from claim 4. For at least the reasons discussed above with respect to the Examiner's rejection of claim 4 under 35 U.S.C. § 102(b), therefore, the combination of items U and V and the Official Notice also does not teach or suggest all of the elements recited in Applicants' claims 6-9.

*Claims 11, 15-17 and 20-21*

Claims 11, 15-17 and 20-21 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over items U (Homestore.com) and V (The Wall Street Journal article) in view of U.S. Pat. No. 6,260,024 issued to Shkedy. Applicants respectfully request reconsideration and withdrawal of this rejection.

Claim 11 is directed to a marketplace, implemented on a computer network, for the sale of services relating to moving, the sale of services taking place between a self-help moving customer and a vendor. The marketplace includes a customer application for processing customer input entered by a customer once in the marketplace. The customer input includes a pre-payment for a service transaction wherein the pre-payment is held in a first account. The marketplace also includes a vendor application for processing vendor input entered by a vendor offering a moving related service. The vendor input includes a confirmation code to activate transfer of funds from the first account to a second account, the confirmation code comprising payment data, job data, and vendor data. The marketplace also includes an administrative application for allowing a marketplace host to maintain the marketplace and gather transactional data from the customer application and the vendor application. Claim 15 includes all of the features of claim 11 and further recites that the customer application accepts input relating to the

customer from an external source to expedite processing customer input and processing vendor input.

Applicants respectfully submit that claims 11 and 15 are patentable over items U and V and Shkedy for at least the following reasons. As discussed above, it is improper to combine items U and V and Shkedy. Shkedy is directed to a different problem than items U and V and than Applicants' invention, i.e. Shkedy is directed to pooling offers from a "multiplicity of buyers" and "multiplicity of sellers" for a particular service or product and ultimately managing the process of the transaction for that service or product between them.

Even if it were proper to combine items U and V and Shkedy, Applicants respectfully submit that that combination does not teach or suggest all of the features of Applicants' claims 11 and 15. At the very least, none of the references, taken alone or in combination, teaches or suggests a "vendor application for processing vendor input entered by a vendor offering a moving related service, the vendor input including a confirmation code to activate transfer of funds from the first account to a second account, the confirmation code comprising payment data, job data, and vendor data," as recited in claims 11 and 15. Thus, Applicant submits that these claims are patentable over items U and V and Shkedy, taken alone or in combination.

Claim 16 is directed to a method for facilitating moving. The method includes: going to a web site operated by a host on a computer network; obtaining a first service or a first good related to moving; and obtaining a second service or a second good related to moving, wherein a payment is made by a customer for the second service or the second good and is held in an escrow account arranged by the host until payment data, job data, and vendor data are provided. Claim 17 is directed to a method for facilitating moving. The method includes: going to a web site operated by a host on a computer network; obtaining a first service or a first good related to moving; selecting from a service list and a vendor list for a second service or a second good related to moving; and obtaining the second service or the second good, wherein a payment is made by the customer for the second service or the second good and is held in an escrow account arranged by the host until payment data, job data, and vendor data are provided.

Applicants respectfully submit that claims 16 and 17 are patentable over items U and V and Shkedy for at least the following reasons. As discussed above, it is improper to combine

Response to Office Action  
US Patent Application No. 10/083,726

items U and V and Shkedy. Moreover, even if it were proper to combine items U and V and Shkedy, Applicants' combination does not teach or suggest all of the features of Applicants' claim 17. At the very least, the Examiner's proposed combination does not teach or suggest "obtaining the second service or the second good, wherein a payment is made by the customer for the second service or the second good and is held in an escrow account arranged by the host until payment data, job data, and vendor data are provided," as recited in claim 17. Thus, Applicant submits that claim 17 patentable over items U and V and Shkedy, taken alone or in combination.

Each of claims 20 and 21 is directed to a computer system for providing auxiliary services in an online marketplace relating to an originating transaction between a customer and a host. In rejecting claims 20 and 21, the Examiner relies on his rationale for rejecting claims 11, 15 and 17. For at least the reasons set forth above with respect to claims 11, 15 and 17, therefore, Applicants respectfully submit that claims 20 and 21 are patentable over items U and V and Shkedy, taken alone or in combination.

*Claims 12 and 13*

Claims 12 and 13 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over items U and V in view of Shkedy and further in view of the Examiner's Official Notice regarding moving services. Applicants respectfully request reconsideration and withdrawal of this rejection.

For the reasons discussed above, Applicants respectfully submit that it is improper to combine items U and V, Shkedy and the Official Notice. In any event, claims 12 and 13 depend from and include all of the features of claim 11. For at least the reasons discussed above with respect to claim 11, therefore, Applicants also respectfully submit that the proposed combination does not teach or suggest all of the features of claims 12 and 13 and that those claims are therefore patentable over the proposed combination.

*Claim 14*

Claim 14 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over items U (Homestore.com) and V (iMove.com) in view of U.S. Pat. No. 6,260,024 issued to Shkedy and further in view of item W(PR Newswire). Applicants respectfully request reconsideration and withdrawal of this rejection.

Response to Office Action  
US Patent Application No. 10/083,726

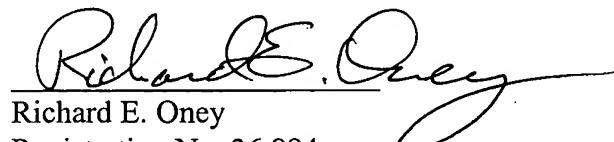
For the reasons discussed above Applicants respectfully submit that it is improper to combine items U and V, Shkedy and item W. In any event, claim 14 depends from and includes all of the features of claim 11. For at least the reasons discussed above with respect to claim 11, Applicants respectfully submit that the proposed combination also does not teach or suggest all of the features of claim 14 and that claim 14 is therefore patentable over the proposed combination.

Conclusion

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete reply has been made to the outstanding Office Action and, as such, the present application is in condition for allowance. If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at the number provided.

Dated: July 11, 2005

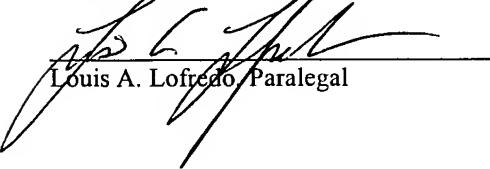
Respectfully submitted,

  
Richard E. Oney  
Registration No. 36,884  
Tiffany & Bosco, P.A.  
2525 E. Camelback Road, Third Floor  
Phoenix, Arizona 85016  
Tel: (602) 255-6094

Express Mail Label No. EV 426789326 US

Date of Deposit July 11, 2005

I hereby certify that this paper and all documents and any fee referred to herein are being deposited on the date indicated above with the U.S. Postal Service "Express Mail Post Office to Addressee" service under 37 C.F.R. § 1.10, postage prepaid and addressed to the Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

  
Louis A. Lofteao, Paralegal

7-11-05  
Date of Signature